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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,199	04/13/2004	Akio Saiki	1004378.51670 (5000-5167)	4036
85775 7590 10/19/2010 Locke Lord Bissell & Liddell LLP Attn: IP Docketing Three World Financial Center New York, NY 10281-2101				
EXAMINER				
PARVINI, PEGAH				
ART UNIT		PAPER NUMBER		
1731				
NOTIFICATION DATE		DELIVERY MODE		
10/19/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptopatentcommunication@lockelord.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/823,199

Applicant(s)

SAIKI ET AL.

Examiner

PEGAH PARVINI

Art Unit

1731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 October 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3,4,7,15-19 and 21-22.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Anthony J Green/
Primary Examiner, Art Unit 1731

Continuation of 11, does NOT place the application in condition for allowance because:

Applicants have argued since the glass transition temperature of polyamide is 70C, polyamide is not suitable for use in the sliding part; thus, Sakashita et al. does not meet the limitation of instant claims. The examiner, respectfully, submits that instant claims recite "comprising"; thus, other components, in addition to what are recited in instant claims, may be present in the claimed composition. Furthermore, the reference suggests the use of all the claimed components and make their content and size, where applicable, obvious. Thus, the reference is clearly seen to make the instant invention obvious absence evidence proving the contrary. In the case of resin, the reference discloses the use of polyamide-imide.

Applicants have argued that Examples 1-6 of the reference disclose that their composition distorts at temperatures in the order of 140C or 173C, and then argue that a composition which distorts at such a temperature is not suitable for use in sliding film for sliding parts. The examiner, respectfully, submits that "A reference can be used for all it realistically teaches and is not limited to the disclosure in its specific examples." In re Van Marter et al. 144 USPQ 421; In re Windmer et al. 147 USPQ 518; In re Chapman et al. 148 USPQ 71. Considering the fact that the reference discloses all the claimed component and make the instant claims obvious as detailed out in the previous Office Action, and considering the fact that the instant claims recite the phrase "comprising", the composition disclosed by the reference as a whole is expected to have characteristics that applicants argue that are seen in their claimed composition absence evidence to the contrary. In other words, how could the claimed composition can be use in wear resistance and sliding part, but a very similar composition by the reference disclosing the claimed components and making them (including their content and size where applicable) obvious, cannot be used.

Applicants have argued that although Example 7 discloses greater than 250C distortion temperature, it shouldn't count because said example utilizes 20% of glass fibers, which as applicants claim, cause the high distortion temperature. The examiner, respectfully, submits that the use of the phrase "comprising" in the recitation of instant claims allows for the use of other components in the claimed composition which are not limited to the recited resin, titanium dioxide, polytetrafluoroethylene, and silane coupling agent. Furthermore, again, it is noted that a reference is not limited to its examples, but that it should be considered as a whole.

Applicants have argued that the imides used by the reference are exemplified as "stabilizers, plasticizers, parting agents, lubricants and fillers", and the imide-based resins of the instant application under examination act as binder resin. The examiner, respectfully, submits that the reference discloses the claimed components and makes their content and size, where applicable, obvious as detailed out in the previous Office actions. Therefore, while the same components are used, the same effect is expected to be seen. Just because the reference group the components under different category of components, does not mean that the reference can't make the instant application obvious, again, because the reference suggest all the claimed components.

With reference to Exhibit C and D, there is not description as why they were filed. Since these two exhibits refer to two different patents, for them to be considered, they should be filed in a filing of an IDS.